

Serial No.: 09/748,706
Filed: December 22, 2000

REMARKS

The claims as presented here include a clean version of the claims as amended in the response to office action mailed April 13, 2004. Applicants respectfully request entry of the amendments and consideration of the remarks submitted in the response to office action filed April 13, 2004.

In addition, claims 52-54 are new. Support is found in the claims as filed and at p. 15, lines 16-35. Applicants submit that no new matter is introduced by way of this amendment. Applicants respectfully request consideration of the comments submitted herein in response to the Advisory Action mailed April 26, 2004.

Response to Advisory Action

The Examiner indicated in the Advisory Action that the amendments to claims 40 and 42 which further define the identifier binding ligand as being directly attached to the microsphere potentially raise issues of new matter. Applicants respectfully disagree. Applicants have provided several examples in the specification, as noted by the Examiner, of direct attachment of oligonucleotides to microspheres. In addition, Applicants previously referred to the figures as additional support for direct attachment of the oligonucleotides to the microspheres, although the Examiner did not acknowledge this. Nonetheless, as demonstrated in the figures, the identifier binding ligands are directly attached to the microspheres, e.g. they do not require in direct association with the microspheres by forces such as hybridization. For example, Figure 10 depicts direct attachment of oligonucleotides to a microsphere via an amino group. As noted in the specification, other methods of linking nucleotides are known in the art.

Accordingly, Applicants respectfully remind the Examiner that the essential purpose of the written description requirement is to show the possession of the invention as of the filing date. *In re Smith*, 481 F.2d 910, 178 U.S.P.Q. 620, 623 (CCPA 1973). Accordingly, the specification is required to contain a statement that adequately

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describes the invention as claimed. However, the invention need not be described in *ipsis verbis* in order to satisfy the description requirement. *In re Luckach, Olson and Spurlin*, 169 U.S.P.Q. 795, 796 (CCPA 1971). It is only required, for example, that the specification describe the invention sufficiently for those of ordinary skill in the art to recognize that the applicants invented the subject matter he now claims. *In re Voss*, 557 F.2d 812, 194 USPQ 267, 271 (CCPA 1977). Here. Applicants submit that the specification, including the description and the drawings provide adequate written description of the identifier binding ligand directly attached to the microsphere as claimed such that one of ordinary skill in the art would know that Applicants invented the subject matter they now claim.

Accordingly, Applicants submit that the amendment of April 13, 2004 does not introduce new matter. Applicants respectfully request entry of the amendment and consideration of the arguments submitted therein.

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CONCLUSION

Applicants submit that the claims are in condition for allowance, and early notification to this effect is solicited. The Examiner is invited to contact the undersigned at (415) 781-1989 if any issues remain.

Respectfully submitted,
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